

**REMARKS**

At the time of the Office Action dated October 19, 2006, claims 1-17 were pending and rejected in this application.

**CLAIMS 8-10 ARE REJECTED UNDER 35 U.S.C. § 101**

On page 2 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 8-10, is directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner asserted that the claimed "system including a hosting environment, a repository, and a classification processor ... can reasonably be considered as being software alone." Applicants respectfully disagree. In this regard, the Examiner is referred to M.P.E.P. § 2106.01, entitled "Computer-Related Nonstatutory Subject Matter." Specifically, this section describes that "descriptive material" is nonstatutory "when claimed as descriptive material *per se*." The claimed invention, however, is not claimed as descriptive material *per se*. Instead, the claimed invention is claimed as part of a functional device (i.e., a repository, a classification processor).

Referring to M.P.E.P. § 2106.01(I), it is stated that "[d]ata structure not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer." A repository and a classification processor, however, do cause a functional change in a computer. Applicants,

therefore, submit that the claimed invention, as recited in claims 8-10, is directed to statutory subject matter, and thus, Applicants respectfully solicit withdrawal of the imposed rejection of claims 8-10 under 35 U.S.C. § 101.

**CLAIMS 1-4, 6-9, 11-14, AND 16-17 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING  
ANTICIPATED BY LANNING, U.S. PATENT NO. 5,787,285 (HEREINAFTER LANNING)**

On pages 3-5 of the Office Action, the Examiner asserted that Lanning discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

**Claims 1 and 11**

Independent claims 1 and 11 each recite the following limitations:

- enumerating each of a set of components in an application;
- identifying dependencies between each component in said set.

To teach these limitations the Examiner cited Figure 5, items 565-574, and item 564 of Lanning and asserted that "basic blocks ... include segments A, B, C, ..." and "basic blocks are interconnected by flow control paths." Therefore, the Examiner is asserting the claimed "components in an application" are identically disclosed by the basic blocks taught by Lanning.

Referring to column 5, lines 20-25, Lanning states the following with regard to basic blocks:

The term "basic block" means any set of instructions in a computer program, whether object or source code, which is a straight line sequence of code into which branches reach only its first instruction, and from which control leaves the basic block only after the last instruction in the block.

To identically disclose the claimed identifying dependencies between these build blocks (i.e., the alleged claimed components), the Examiner must therefore be relying upon the teaching within Lanning of "flow control paths (e.g., 564) between these basic blocks." As described by Lanning, these flow control paths "represent the executable paths the application program can take between basic blocks."

Applicants note that the claimed invention recites "identifying dependencies between each component in the set." A dependency is "something that is dependent on something else."<sup>1</sup> The definition of dependent is "2a: determined or conditioned by another ... b(1): relying on another for support."<sup>2</sup> There is, however, no explicit disclosure within Lanning that the basic blocks have inter-dependencies or that they are "determined or conditioned by another," so as to meet the claimed limitations of "identify dependencies." The teachings of Lanning do not "identifying dependencies;" instead, Lanning teaches illustrating flow control paths that represent the executable paths an application program can take between basic blocks.

Applicants recognize that dependencies may occur between the various basic blocks taught by Lanning. However, Lanning does not teach identifying those dependencies or that these dependencies are identified by the flow control paths. Moreover, the Examiner cannot assert that Lanning inherently teaches identifying these dependencies because inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from

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<sup>1</sup> <http://www.m-w.com/dictionary/dependency>.

<sup>2</sup> <http://www.m-w.com/dictionary/dependent>.

a given set of circumstances is not sufficient to establish inherency.<sup>3</sup> To establish inherency, the extrinsic evidence must make clear that the missing function must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.<sup>4</sup> This burden has not been met by the Examiner. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

### Claims 2 and 12

To teach the limitations recited therein, the Examiner relied upon Fig. 4B and item 416 of Lanning. For ease of reference, these teachings are described in column 6, lines 49-54 of Lanning and reproduced below:

Referring now to FIGS. 4A and 4B, the routine proceeds, via off-page connectors 412 and 414, to the next step 416 which compares, for each basic block (i.e., A,C and D) reachable from only entry point #1 (561, FIG. 5), the block's frequency of execution for profile P1 against a predetermined threshold value.

Upon reviewing this passage, Applicants are unclear as to how Lanning teaches identifying dependencies between target platform resources and the components in a set. A comparison of a frequency of execution against a predetermined threshold value is not identifying a dependency. The applied prior art must sufficiently describe Applicants' claimed invention to place the invention within the possession of one having ordinary skill in the field of the invention. However, although this disclosure requirement presupposes the knowledge of one skilled in the

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<sup>3</sup> In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

<sup>4</sup> Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art teachings that are not there.<sup>5</sup>

Moreover, the Examiner is to construe the claim language consistent to the plain and ordinary means attributed to the claimed language by one having ordinary skill in the art. In this regard, Applicants note that the Examiner has not put forth any analysis that would support the notion that one having ordinary skill in the art would consider the teaching of comparing a frequency of execution against a predetermined threshold value as identically disclosing a dependency between the CPU (i.e., the alleged resource) and the basic block (i.e., the alleged component).

#### Claims 3 and 13

The Examiner's statement on page 4 of the Office Action fails to establish that Lanning identically discloses the claimed invention. Both the flow control path and the passage (i.e., column 5, lines 18-20) cited by the Examiner do not describe that the flow control path is either inspected for (or contains) "data and method member references to other ones of said components."

#### Claims 4 and 14

Similar to the arguments submitted by Applicants immediately above, the Examiner's statement on page 4 of the Office Action fails to establish that Lanning identically discloses the claimed invention. The teaching of comparing a frequency of execution against a predetermined

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<sup>5</sup> Motorola, Inc. v. Interdigital Tech. Corp., 43 USPQ2d 1481 (Fed. Cir. 1997).

threshold does not describe that the flow control path (i.e., the alleged component) is either inspected for (or contains) "data and method member references to said platform resources."

Claim 8

Independent claim 8 recites a repository configured to store a dependency model of an application. However, as described above with regard to claims 1 and 11, Lanning does not teach identifying dependencies. Since dependencies are not identified, Lanning does not teach generating (or storing) a dependency model.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1-4, 6-9, 11-14, and 16-17 under 35 U.S.C. § 103 for anticipation based upon Lanning is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 5, 10, AND 15 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED  
UPON LANNING IN VIEW OF BALLANTYNE ET AL., U.S. PATENT PUBLICATION NO.  
2001/0044811**

On page 6 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lanning in view of Ballantyne to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 5, 10, and 15 respectively depend from independent claims 1, 8, and 11, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1, 8, and 11 under 35 U.S.C. § 102 for anticipation based upon Lanning. The

secondary reference to Ballantyne does not cure the argued deficiencies of Lanning. Accordingly, even if one having ordinary skill in the art were motivated to modify Lanning in view of Ballantyne, the proposed combination of references would not yield the claimed invention.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

Application No.: 10/726,192

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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